

REMARKS

Claims 8, 11, 12 and 21-29 are pending in the application.

Claims 21 and 25-29 are allowed.

Claims 22-24 are rejected.

Claims 8, 11 and 12 are objected to.

Reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 103**

Claims 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Callon (US 5,699,347) in view of Rochberger (US 6,061,736). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more

the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With regards to independent Claims 22-24, the Office Action argues that Callon discloses a communication network and method including, inter alia, "if a connection can not be established to the destination via the first gateway, randomly selecting a second gateway from among the gateways other than the first gateway, and sending a connection request to the second gateway 470 and 474", citing Fig. 11 and Col. 15, lines 28-42 of Callon, see Office Action, page 3.

Callon recites that four possible routing paths (Path 1, Path 2, Path 3, Path 4) are calculated. See, FIGURE 10 and Col. 14, lines 11-67. Then, Callon determines that one of the four paths will

be used to send the data packet. See, FIGURE 11 and Col. 12, lines 24-42. Upon determination of the selected path, Callon forwards the data packet on the path. In general terms, once a path is selected and the data packet is forwarded, Callon does not address or disclose what actions or steps, if any, would be taken if a connection cannot be established in response to a connection request. Callon does not disclose a method, apparatus, or node for “sending a connection request to a first gateway” (the determined gateway) and if a connection cannot be established, “randomly selecting a second gateway” and sending a connection request to the second gateway. Claims 22-24. The Applicants respectfully submit that the cited figure and text of Callon do not disclose these elements/features recited in the Claims 22-24.

The Office Action further argues that Rocheberger discloses certain elements/features and therefore it would be obvious “to include the randomly selection of one link with the optimum metric in a plurality of links . . .” Office Action, page 4. However, the Applicant respectfully submits that Rocheberger is silent with respect to deterministically selecting a first gateway, sending a connection request, and if a connection can not be established via the first gateway, randomly selecting a second gateway, sending a connection request to the second gateway, and if the connection cannot be established the step of randomly selecting a second gateway (deterministically selecting a first gateway) is repeated, and the selection is limited to gateways through which a connection has not already been attempted. See, Claim 23 (and Claim 24). Rocheberger fails to address what action(s) should/would be taken if a connection to a destination cannot be established.

Therefore, Rocheberger and Callon, either taken alone or in combination, fail to disclose, teach or suggest repeating a step if a connection cannot be established, and limiting the selection to gateways through which a connection has not already been attempted. Claims 23-24.

Similarly, neither reference disclose, teach or suggest repeating a step if a connection cannot be established, as none of the cited references address or identify steps/actions are to be taken when a connection cannot be established (in response to a connection request).

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 22-24.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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